

DETAILED ACTION

Status of Claims

Claims 1, 6-20, 22, and 23 are pending. Claims 2-5 and 21 are canceled. Of the pending claims, claims 6-20 are withdrawn from consideration, and claims 1, 22, and 23 are presented for examination on the merits. Claim 1 is independent.

Status of Previous Rejections under 35 USC § 112

The previous rejections of claims 2-4 under the second and fourth paragraphs of 35 U.S.C. 112 are moot in view of their canceled status.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oishi et al. (WO 02/099148) in view of *Webster's New World Dictionary* (Third College Edition, p. 1206). (Note: Prior art document WO 02/099148 is published in the Japanese language. Since US 2004/0163744 A1 is a publication of the national stage application of PCT/JP02/04759 (published as WO 02/099148), it will be used as the English language translation of WO 02/099148. Accordingly, unless otherwise stated,

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all paragraph citations referencing the Oishi et al. document refer to the US 2004/0163744 reference.)

Claims 1, 22, and 23 remain rejected for substantially the same reasons presented in the Office action dated 5/4/2011.

Regarding the amended portion of claim 1, Oishi et al. disclose a magnesium-based alloy that contains the following elements, in percent by mass (paragraph [0022]):

| Element | Claim 1 first alloy listed | US 2004/0163744 A1 WO 02/099148 |
|---------|-------------------------------|------------------------------------|
| Al | 5.5 - 7.2 | 5.5 - 7.2 |
| Zn | 0.4 - 1.5 | 0.4 - 1.5 |
| Mn | 0.15 - 0.35 | 0.15 - 0.35 |
| Ni | 0.05 or less | 0.05 or less |
| Si | 0.1 or less | 0.1 or less |
| Mg | base | base |

The claimed ranges are identical to the ranges taught in the prior art.

Response to Arguments

3. Applicant's arguments filed 8/4/2011 have been fully considered but they are not persuasive.

First, Applicant argues that Oishi does not disclose a specific screw. In response, the argument is not commensurate in scope with the claimed invention, as the claim does not specify a specific screw. The claim merely requires that the screw have a head and threaded portion, but these features do not make a screw specific, as they are standard characteristics of screws. See *Webster's New World Dictionary* definition of a screw (p. 1206).

Second, Applicant argues that Oishi does not teach any method of forming a screw. In response, the patentability of product-by-process claims does not rest on the method of manufacturing the claimed product. When the prior art discloses a product appearing to be identical or substantially identical to the claimed product (as it does in Oishi), the burden falls on Applicant to show an unobvious difference. See MPEP § 2113. Applicant has not yet showed how the screw, which is made from the wire of Oishi, differs from the claimed screw.

Third, Applicant argues that Oishi does not teach a screw having a tensile strength of 220 MPa or higher. In response, Oishi teaches that its wires are used in the manufacture of screws because its wires have mechanical properties and characteristics that are favorable to screws; therefore, one of ordinary skill in the art would expect those same mechanical properties and characteristics of the wire to convey to a screw formed from the wire. Thus, Oishi suggests a screw with the same properties or substantially the same properties as that of the wire, including a tensile strength exceeding 250 MPa.

Fourth, Applicant appears to suggest that if the wire of Oishi were subjected to a conventional process for making a screw, the conventional process would produce a screw having a tensile strength lower than the claimed range due to grain coarsening at working temperatures above 250°C. In response, Oishi teaches that a magnesium alloy AZ61 (identical to first claimed alloy) wire, even if annealed at temperatures as high as 400°C, would still have a tensile strength of 310 MPa, which lies within the claimed range. Therefore, it does not appear that even working the wires of Oishi at

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temperatures higher than 250°C would degrade the tensile strength of a screw formed at those temperatures to a level below 220 MPa.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANESSA LUK whose telephone number is (571)270-3587. The examiner can normally be reached on Monday-Friday 9:30 AM-4:30 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached at 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/VANESSA LUK/

Examiner, Art Unit 1733

/Scott Kastler/

Primary Examiner, Art Unit 1733